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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,392	01/30/2002	Marietta V. Sperry	T9355.NP	4635
20551	7590	01/11/2005		
THORPE NORTH & WESTERN, LLP. 8180 SOUTH 700 EAST, SUITE 200 P.O. BOX 1219 SANDY, UT 84070				
			EXAMINER HENDERSON, MARK T	
			ART UNIT 3722	PAPER NUMBER

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/066,392	<b>Applicant(s)</b> SPERRY, MARIETTA V.	
	<b>Examiner</b> Mark T Henderson	<b>Art Unit</b> 3722	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-21 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Response to Amendment***

1. The affidavit filed on October 12, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the prior art reference as stated in the rejections given below.

The Moor et al and Hatano et al references are U.S. patents that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application

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are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the patent may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Moor et al (6,431,779).

Moor et al discloses in Fig. 4, an organizer comprising: a closed position (Fig. 2) and an expanded position (Fig. 4); an expanding plurality of pockets for holding sheets (Col. 3, lines 34 and 35); and wherein the organizer has a front wall (14) and a rear wall (12) which are transparent

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such that a color aspect of contents of the organizer and be visually appreciated (Col. 3, lines 23-33); and wherein the organizer is made out of polypropylene (Col. 1, lines 61 and 62).

However, Moor et al does not disclose wherein the pockets are configured for holding 12 x 12 sheets.

It would have been an obvious matter of design choice to construct the pockets to hold any desirable sized sheets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to modify Moor et al's organizer to a size which can accommodate a variety of unfolded sheet sizes, since such a change would not alter the function of the pocket for holding sheets of paper, and it would be based upon the item the end user would want to place in the pocket.

Furthermore, in regards to the pockets "configured for holding and protecting 12 x 12 sheets, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, Moor et al's organizer is capable of holding 12 x 12 sheets in an unfolded condition.

Furthermore, an organizer having pockets which can constructed to accommodate a number of sheet sizes as desired by the end user is notoriously well known in the art.

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3. Claims 1-6, 20 and 21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hatano et al (5,741,028) in view of Hatano et al's prior art.

Hatano et al discloses in Fig. 1-3, an expandable transparent organizer comprising: a closed position (Fig. 2) and an open position (Fig. 3); a plurality of first expanding pockets (30) for holding sheets; and wherein the organizer has a front wall (11) and a rear wall (14), which are configured for holding and organizing contents; a second pocket (seen in Fig. 1), which can be seen when the organizer is in a closed position (since cover walls (15) are transparent). The method of organizing materials is inherently taught by Hatano et al as modified by Hatano's prior art.

However, Hatano et al does not disclose pockets for holding 12 x 12 unfolded sheets; and wherein the organizer is configured such that at least an aspect of contents can be visually appreciated (transparent) through a wall of the container.

Hatano et al's prior art (as indicated in Col. 1, lines 10-12), discloses a folder wherein the walls of the container can be transparent and made out of plastic.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hatano et al's organizer to include transparent cover walls as taught by Hatano et al's prior art for the purpose of visually appreciating the color aspect of the contents.

In regards to **Claim 1**, it would have been an obvious matter of design choice to construct the pockets to hold any desirable sized sheets, since such a modification would have involved a

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mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been obvious to modify Hatano et al's organizer to a size which can accommodate a variety of unfolded sheet sizes, since such a change would not alter the function of the pocket for holding sheets of paper, and it would be based upon the item the end user would want to place in the pocket.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the walls out of any desirable plastic component such as polypropylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to modify Hatano et al organizer with walls constructed out of any desirable plastic component, since applicant has not disclosed that a particular plastic component is critical to his invention, and that the organizer walls would work equally as well with any transparent component.

Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, Hatano et al's organizer is capable of holding 12 x 12 sheets in an unfolded sheets.

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4. Claim 7-18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hatano et al in view of Hatano's prior art and further in view of Lee et al.

Hatano et al as modified by Hatano et al's prior art discloses an organizer comprising all the elements as claimed in Claim 1, and as set forth above. Hatano et al further discloses that the second pocket (seen in Fig. 1) that can be seen when the organizer is in a closed position (since cover walls are transparent). However, Hatano et al does not disclose: a second and third see-through pocket configured to hold data storage media and computer disks.

Lee et al discloses in Fig. 1 and 2, discloses a second pocket for holding a data storage medium (28) and a third pocket for holding a computer disk, wherein the walls (cover) of the pockets are see through.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hatano et al's and Hatano et al's prior art organizer to include a second and a third pocket as taught by Lee et al for the purpose of holding additional information as well as labeling the organizer.

5. Claim 19 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hatano et al in view of Hatano's prior art and Lee et al, and further in view of Shannon (4,784,508).

Hatano et al as modified by Hatano's prior art and Lee et al discloses an organizer comprising all the elements as disclosed in Claim 11, and as set forth above. However, Hatano et al does not disclose a transparent substrate (pocket wall) being color tinted.



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Shannon discloses in Fig. 1, a transparent plastic substrate (in this case tab (16), as disclosed in Col 2, lines 50-55) which can be color tinted.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hatano et al's organizer with a color tinted transparent substrate as taught by Shannon for indexing purposes.

#### ***Response to Arguments***

In response to applicant's arguments that the prior art does not disclose an accordion-style, archival safe organizer having pockets configured for holding 12 x 12 unfolded sheets, the examiner submits that although the limitation of "an accordion-style" is not stated in the claims, the Moor et al does indeed meet the claim. The Hatano et al reference on the other hand does not disclose an "accordion-style" organizer, however, since applicant has not claimed this limitation, the examiner did not consider the limitation in the rejections. Both reference also disclose an organizer made of polypropylene which is archival safe. Although, both references do not teach an organizer for holding 12 x 12 sheets in an unfolded position, the examiner submits that it would have been an obvious matter of design choice to construct the pockets to hold any desirable sized sheets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

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Therefore, it would have been obvious to modify Moor et al's organizer to a size which can accommodate a variety of unfolded sheet sizes, since such a change would not alter the function of the pocket for holding sheets of paper, and it would be based upon the item the end user would want to place in the pocket. Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, Moor et al's organizer and Hatano et al's organizer are capable of holding unfolded sheets. Furthermore, an organizer having pockets and sized to accommodate sheets of any size is well known in the art, as indicated by Wien (6,250,834) and in Lehmann et al (6,168,340), who disclose an organizer having pockets sized to accommodate large sheets.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

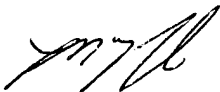
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


#### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

January 9, 2005



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